

The opinion in support of the decision being entered today is
not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIETRICH CHARISIUS and PETER COAD

Appeal 2006-2496
Application 09/944,696
Technology Center 2100

Decided: September 18, 2007

Before JAMES D. THOMAS, ALLEN R. MACDONALD,
and JAY P. LUCAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 3-17, 28-31 and 38-44. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a).

Representative independent claim 3 is reproduced below as best representative of the disclosed and claimed invention:

3. A method in a data processing system having versions of a plan, each reflecting an instance in an edit history, the method comprising the steps of:

storing indications of the versions of the plan; and

displaying the versions of the plan in a sequential manner to simulate animation of the edit history;

wherein said displaying is visually distinctive as a function of frequency of change in the edit history.

The following references are relied on by the Examiner:

Garofalakis	US 5,845,279	Dec. 1, 1998
Nauckhoff	US 5,893,128	Apr. 6, 1999
Boden	US 5,930,512	Jul. 27, 1999
Kumashiro	US 6,240,395 B1	May. 29, 2001 (filed Dec. 10, 1998)

Microsoft ® Word 2000, "About adding comments and keeping track of changes", pp. 1-2 and Fig. 1, 1999

"ls", <<http://polyglotman.sourceforge.net/sgi-ls.1.html>>, 2000, pp. 1-7

Claims 3-17, 28-31 and 38-44 stand rejected under 35 U.S.C.

§ 103(a). As evidence of obviousness, the Examiner combines Boden with Nauckhoff and Microsoft ® Word 2000 for the first stated rejection of claims 3-10, 13-15, 28, 38, 41 and 44¹. For the second stated rejection of claims 11, 16, 30, 39 and 42, the Examiner combines Boden, Nauckhoff and

¹ Claims 28 and 44 were inadvertently omitted from the statement of the rejection in the Answer, but were rejected in the body of the rejection.

Microsoft ® Word 2000 with “ls”. For the third stated rejection of claims 12, 17, 31², 40 and 43, the Examiner combines Boden, Nauckhoff and Microsoft ® Word 2000 with Kumashiro. Finally, the Examiner combines Boden, Nauckhoff and Microsoft ® Word 2000 with Garofalakis for the fourth stated rejection of claim 29.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for the Appellants’ positions, and to the Answer for the Examiner’s positions.

OPINION

We affirm.

Of independent claims 3, 13, 28, 38, 41 and 44 included within the first stated rejection under 35 U.S.C. § 103(a), Appellants only present arguments to these independent claims collectively, and present no separate arguments to the remaining dependent claims encompassed by this rejection. We will address independent claim 3 as representative of all independent claims.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148

² Claim 31 was inadvertently omitted from the statement of the rejection in the Answer, but was rejected in the body of the rejection.

USPQ 459, 467 (1966). Furthermore, ““there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1443, 1444 (Fed. Cir. 2006)). In this appeal, we are satisfied the Examiner has met the requirements of the recent precedent, as embellished upon here.

We initially note that Appellants have presented only a general argument that there is no teaching, suggestion or motivation for combining the cited references, and have not presented any specific arguments refuting the rationale set forth by the Examiner for combining the references.

Appellants present three principal arguments against the first stated rejection: 1) Microsoft ® Word 2000 fails to disclose displaying a frequency change in edit history (Br. 5); 2) a document generated using Microsoft ® Word 2000 is not a plan (Br. 6); and 3) the term “function of frequency” is a limiting term that requires a mathematical correspondence that assigns a value to a variable as a function of frequency (Reply Br. 1-2).

Regarding the first argument, the Examiner disagrees, and cites to page 2, paragraph 2 of Microsoft ® Word 2000 (Answer, 14). We agree with the Examiner, and find that the cited portion of Microsoft ® Word 2000 teaches storing multiple versions of a document, and allowing a user to display a listing of each version using the “Versions dialog box”. By

displaying all previous versions of a document, accompanied by a date and time the version was saved, Microsoft ® Word 2000 permits a user to display a frequency of change in edit history. By examining the quantity of versions and the dates accompanying each version, the user can quickly determine the frequency and “visual distinctiveness” associated with the editing of the document.

Regarding the second argument, the Examiner agrees with Appellants that a document generated by Microsoft ® Word 2000 is not a plan (Answer, 14). However, the Examiner asserts that Microsoft ® Word 2000 was relied upon only for its teaching of displaying a frequency of changes in an edit history, and that the primary reference to Boden teaches a plan (Answer, 14). We agree with the Examiner that Boden teaches a plan as claimed, and that one of ordinary skill in the art would have been motivated to combine the teachings of Microsoft ® Word 2000 with Boden to permit users to display one or more previous versions of a plan to determine which elements have changed.

Moreover, we see no reason why a document generated using Microsoft ® Word 2000 could not be a plan or be used to animate a workflow process of a plan, as asserted by Appellants (Br. 6). A Word document containing text and/or graphics may be a plan itself, and may also display graphics suitable to simulate animation of an edit history.

Regarding the third argument, presented for the first time in the Reply Brief, Appellants argue that the term “function of frequency” requires a mathematical correspondence that assigns a value to a variable as a function of frequency (Reply Br. 1), and direct attention to ¶186 of the Specification

(Reply Br. 2). Although the originally filed specification does not contain paragraph numbering, the relevant paragraph may be found at page 43, lines 15-27. We have reviewed the cited paragraph and the remainder of the Specification and we find that Appellants have not provided a definition for either “function of frequency” or “function”. Appellants apparently recognize this omission, and attempt to rely on definition 5a of the term “function” from Merriam Webster’s online dictionary (Reply Br. 1-2). We are not convinced by this argument, particularly because definition 5b of Merriam Webster’s online dictionary alternatively defines “function” as “a variable that depends on and varies with another”. This definition is much broader than the definition argued by Appellants, and we find that the display of each version of an edit history accompanied by the date and time it was saved “depends on and varies with” the frequency of change in that edit history, since more versions will be displayed with date and time stamps closer to each other when the frequency of change is higher. Accordingly, the display in Microsoft ® Word 2000 is visually distinctive as a function of frequency of change in the edit history. Since Appellants’ argued definition is inconsistent with the broadest reasonable interpretation of the term “function”, we decline to incorporate the argued “mathematical correspondence” into the claimed function which has also not been disclosed as such.

Regarding the second stated rejection of dependent claims 11, 16, 30, 39 and 42, since these claims contain substantially identical subject matter, we will treat claim 11 as representative. Appellants argue that the “Is” reference “may show how to [display the versions of a plan or workflow in

reverse order], but it says nothing about why to do it” (Br. 8) and that the operation taught by “ls” is “unsuitable for displaying the versions of the workflow in reverse order” (Reply Br. 3). The Examiner disagrees, and asserts that the plan versions are known to be stored in directories (Answer, 15). As noted by the Examiner, Applicant admits that plan versions are stored in directory folders in the prior art (Specification, 10). Since “ls” teaches displaying a list of files in reverse order, we find that it was suitable for displaying versions of a workflow or plan in reverse order. We also agree with the Examiner that one of ordinary skill in the art would have been motivated to display plans in reverse order to permit the user to view the plan in an alternate order, such as oldest version first or most recent version first.

Regarding the third stated rejection of claims 12, 17, 31, 40 and 43, since these claims contain substantially identical subject matter, we will treat claim 12 as representative. Appellants admit that Kumashiro teaches Gantt charts (flow-type diagrams), but argue that “edits to Gantt charts or flow diagrams will be highlighted with a distinctive indicator such as a tag having a number associated with the frequency of changes made to a particular element of a Gantt chart or flow diagram” (Br. 8). However, as correctly noted by the Examiner (Answer, 15-16), the numerous limitations argued by Appellants do not appear in the rejected claims, which merely state that the display comprises a Gantt chart or flow diagram.

Regarding the fourth and final stated rejection of claim 29, Appellants argue that the combination of Boden, Nauckhoff, Word and Garofalakis fails to teach or suggest the limitations of independent claim 28 (Br. 9).

Appellants also present a general argument that Garofakalis does not provide a suggestion to modify any of the primary references to arrive at the claimed invention (Br. 9). Finally, Appellants argue that Garofakalis fails to disclose the “mathematical correspondence called for by the term ‘function of frequency’” (Reply Br. 4), which appears only in independent claim 28.

We note that Appellants have presented no specific arguments disputing the Examiner’s mapping of Garofakalis to the limitations of claim 29 or the rationale set forth by the Examiner for combining Garofakalis with Boden, Nauckhoff and Microsoft ® Word 2000 (Answer, 13). Accordingly, Appellants have waived any such arguments. Since we find no deficiencies with respect to the rejection of independent claim 28, as discussed *supra*, we will sustain the Examiner’s rejection of dependent claim 29.

Finally, recognizing that this issue has not been argued by Appellants or the Examiner, we note in passing that the nature of the claimed and argued subject matter relates to the content of information being displayed rather than any functionality or methodology involved in causing the display itself, features best described as “non-functional descriptive material”. We need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ 1862, 1864 (Fed. Cir. 2004). In other words, we find that the meaning attributed to the information displayed cannot be used to distinguish the claimed information displayed from prior art displays. *See also Ex Parte Curry*, BPAI Appeal No. 2005-0509 (Appl. No. 09/449,237) (*aff’d*, Appeal No. 06-1003 (Fed.

Cir. Jun. 12, 2006)(Rule 36)(unpublished)); *Ex Parte Mathias*, BPAI Appeal No. 2005-1851 (Appl. No. 09/612,788) 2005 WL 5121483, at *3 (*aff'd*, Appeal No. 06-1103, 2006 WL 2433879 (Fed. Cir. Aug. 17, 2006) (Rule 36)).

In summary, we sustain the Examiner's four stated rejections of claims 3-17, 28-31 and 38-44 under 35 U.S.C. § 103(a). The rejections of these claims encompass all claims on appeal, and all rejections are affirmed. Therefore, the decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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